

REMARKS

The following remarks are submitted to address all issues in this case, and to put this case in condition for allowance. Applicant amends the specification to comply with the Examiner's suggestion that the specification be amended to provide support in the written description for the distal lumen passing through the peripheral portion of the positioning shield. Further, Applicant amends the claims solely to better describe the subject matter of the present invention. No new matter is believed to be added in these amendments. Application claims 1-5, 7-17, 20-27, 30-39, and 45-48 are pending in this application. Application claims 6, 18, 19, 28, 29, and 40-44 have been cancelled. Application claims 1, 27, 30-35, and 45-46 are the only independent claims. Applicant has studied the Office Action mailed February 13, 2009 and responds with the following remarks. These remarks are submitted to address all issues in this case, and to put this case in condition for allowance.

Examiner Interview

Applicant thanks the Examiner for the courtesy of an interview, which was conducted between Examiner Darwin P. Erez and Applicant's attorney, Kirk A. Damman, on May 13, 2009. The participants discussed in detail the §112, first paragraph rejection of the February 13, 2009 Office Action, particularly as it relates to the distal lumen passing through the peripheral portion being supported by the Figures as filed (in particular, FIG. 8). Further discussed (by implication) were the Examiner's §102 and §103 rejections of Applicant's claims.

In particular, Applicant's attorney explained what was viewed as the "distal end" and the "distal lumen" and how the drawings of the original application, as filed, provide support for the limitation of "a distal lumen passing through the peripheral portion of the positioning shield," as seen in FIG. 8. Applicant has amended the specification to clarify that the distal lumen passes through the peripheral portion of the positioning shield, as specifically shown in FIG. 8 of the application as originally filed.

The remarks below are believed by Applicant to comport with the understanding reached between the Examiner and Applicant's attorney during the interview. As suggested by the Examiner at the conclusion of the interview, Applicant requests the courtesy of a telephone call to the below-signed attorney if, for any reason, the Examiner determines that the claims are not allowable.

Amendments to the Specification

Applicants have amended the specification, according to the Examiner's suggestion, to clarify that the distal lumen passes through the peripheral portion of the positioning shield. As this limitation was shown in FIG. 8 as filed in the original application, no new matter is added by this amendment.

35 USC § 112

The Examiner rejected claims 1-5, 7-17, 20-27, 30-33, and 45-48 under 35 U.S.C. 112, first paragraph, as failing comply with the written description requirement. Without regard as to the correctness of the Examiner's rejection, Applicant states that the specification, as amended, provides support for the distal lumen passing through the

peripheral portion of the positioning shield. This amendment adds no new matter as this limitation was depicted in FIG. 8, filed with the original specification. In light of the Applicant's amendments to the specification, the Examiner's § 112, first paragraph, rejection is now believed to be moot. As such, Applicant respectfully requests that the Examiner let these claims pass to issue.

35 U.S.C. § 102 and § 103

The Examiner rejected Applicant's claims 1, 2, 8-14, 17, 20, 25, 26, 33, 35 and 37 under 35 U.S.C. 102(b) as being anticipated by Brain (U.S. 5,355,879); claims 1, 2, 7-14, 20-26, 30, 31, 33, 35, 37, 39, 40 and 46-48 under 35 U.S.C. 102(b) as being anticipated by Callaghan, *et al.* (U.S. Reg. No. 35,531); and claim 34 under 35 U.S.C. 102(b) as being anticipated by Pagan (U.S. 6,240,922).

Applicant's independent claims 1, 27, 30-35, 45 and 46, as amended, each recite, as an element, the distal lumen (of the distal end of the respiratory tube) passing through the peripheral portion of the positioning shield. The Examiner has conceded that neither of his principal prior art references of Brain '879 or Callaghan, *et al.*, disclose this element. Further, with regards to claim 34, Applicant notes that Pagan also fails to disclose this element of the Applicant's present claims. As the Examiner is missing an element of each of Applicant's independent claims, the Examiner can not make out a *prima facie* case of anticipation under § 102. Because all of the pending dependent claims depend from one of Applicant's amended independent claims, Applicant asserts that all of the claims are patentable over the Examiner's cited prior art references of Brain

'879, Callaghan, *et al.*, and Pagan. As such, Applicant respectfully requests that the Examiner withdraw all of his § 102 rejections.

Applicant further respectfully notes that the Examiner's obviousness rejections under § 103 fail for the same reasons the Examiner's § 102 rejections fail; the Examiner is missing the element of the distal lumen passing through a hollow peripheral portion. As noted *supra*, none of the Examiner's principal references discloses the element of a distal lumen passing through a hollow peripheral portion. Further, none of the Examiner's other cited prior art references can fill in this hole. Thus, the Examiner is missing an element of Applicant's independent claims and, as such, can not make out a *prima facie* case for obviousness.

Conclusion

In light of the above remarks and amendments, Applicant believes that all of the Examiner's rejections of the pending claims have been overcome; and since none of the references cited by the Examiner, alone or in combination, anticipate or render obvious all of the elements of the claims presented herein, Applicant respectfully requests that the Examiner withdraw all rejections to the present application and allow this application to pass to issuance.

As a final point, there is also included herewith a petition for a two month extension of time and the associated petition fee. Applicant believes that no further fees are due with this filing; however, the Commissioner is authorized to credit any overpayment or charge any deficiencies necessary for entering this Response, including any claims fees or extension fees to or from our **Deposit Account No. 50-0975**.

If any questions remain, Applicant respectfully requests a telephone call to the below-signed attorney at (314) 444-7600.

Respectfully submitted,
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Dated: July 13, 2009

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